

Remarks

Reconsideration is requested in view of the above amendments and the following remarks. Claim 12 is amended to include the language from prior claim 22 which has been canceled. Claim 12 also refers to “a document substrate” which is supported by the original disclosure at page 1, lines 7-11 which refers to documents comprising substrates and at page 2, lines 28-30 which also imply that the document includes a substrate. Claim 18 is amended to remove the term “identity”. Claim 23 is amended to remove the term “identity” and to include some of the language from claim 26 which has been canceled. Claim 25 is amended to remove the term “identity” and to add the language “or an identity card” which is supported by the original disclosure at page 1, lines 7-8. Claims 31-33 are canceled without prejudice or disclaimer. Applicant reserves the right to pursue claims 31-33 in a separately filed application. New claims 34-35 are added and are supported by the original disclosure, for example page 6, lines 10-12. No new matter has been added. Claims 12-21, 23-25, 27-30 and 34-35 are pending.

35 USC 112, 1st paragraph rejections

Claims 12-30 are rejected as failing to comply with the written description requirement.

The language “identity document substrate” has been removed from claim 12. Instead, claim 12 recites “document substrate” which is supported by, for example, page 1, lines 7-11 which refers to documents comprising substrates, page 2, lines 28-30 which also imply that the document includes a substrate, and page 6, line 9.

The limitation “the protective coating is not secured to the identity document by adhesive” has been removed from the claims.

Withdrawal of the rejection is requested.

Art rejections

Claims 12, 13 and 16-28 are rejected under 35 USC 102(b) as being anticipated by US 5879775 to Walter et al.

In addition, claims 14 and 15 are rejected under 35 USC 103(a) as being obvious in view of Walter and WO 97/48774 to Araki et al.

In addition, claims 21, 29 and 30 are rejected under 35 USC 103(a) as being obvious in view of Walter and US 4765656 to Becker et al.

Applicant traverses the rejections.

With respect to claim 12, Walter does not disclose a substrate provided with information on the surface thereof and adhesion of the information with respect to the protective coating is greater than with respect to the substrate. This feature was previously recited in claim 22 which was rejected on the grounds that such a feature was inherent in Walter since the materials disclosed by Walter are the same as disclosed by Applicant.

To meet the language of claim 12, the adhesion between the information and the coating and between the information and the substrate must be considered. The properties of the material forming the information impact the adhesion (see page 3, line 31 to page 4, line 3 of Applicant's specification).

To conclude that Walter inherently discloses adhesion of the information with respect to the protective coating is greater than with respect to the substrate is incorrect and not supported by Walter. Walter does not describe this feature. Walter discloses details of the card and the coating, but does not disclose anything concerning the adhesive interaction between the optical features and the card or the coating. It is possible from Walter that the adhesion between the optical features and the card is greater than the adhesion between the optical features and the coating, thereby allowing the coating to be removed without destroying the optical features. Since Walter is silent concerning this feature, and since it is possible in Walter that the adhesion between the optical features and the card is greater than the adhesion between the optical features and the coating, to conclude that Walter inherently discloses adhesion of the information with respect to the protective coating is greater than with respect to the substrate is incorrect and not supported by Walter.

For at least this reason, claim 12 is patentable over Walter.

With respect to claim 23, Walter does not disclose a protective coating as claimed disposed over an electronic chip. Walter is silent regarding an electronic chip, and does not contain any suggestion that the protective coating can be applied over a chip.

For at least this reason, claim 23 is patentable over Walter.

Claims 13-21, 24-25, and 27-30 depend from either claim 12 or claim 23 and are patentable along with claims 12 and 23 and need not be separately addressed. Applicant does not concede the rejections to claims 13-21, 24-25 and 27-30 and specifically traverses the assertions that certain claimed features of claims 13-21, 24-25 and 27-30 are inherent in Walter.

In view of the above, Applicant believes that the claims are allowable. Favorable reconsideration in the form of a Notice of Allowance is requested. Any questions or concerns regarding this communication can be directed to the undersigned at (612) 455-3805.




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Respectfully submitted,

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